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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,400	04/13/2004	Ralph Bauer	1055-A4363	3239

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EXAMINER	
YOON, TAE H	
ART UNIT	PAPER NUMBER
1714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/823,400	BAUER ET AL.	
	Examiner	Art Unit	
	Tae H. Yoon	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) 35-52 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-34, drawn to a coating composition, classified in class 524, subclass 444+.

II. Claims 35-52, drawn to a method of forming a coating composition, classified in class 423, subclass 600+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and (are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make another and materially different inorganic composition such as carbon black, and the aspect ratio of group I is not required in Group II.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, and because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Abel on March 12, 2007 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35-52 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 6, 12, 13, 15, 16, 20, 22, 23, 27, 30 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "at least about", "greater than about", "less than about", "not less than about" and "no more than about" are indefinite. It has to be either "about" or "less than", for example. See Amgen, Ins. V. Chugal Pharmaceutical Co., Ltd., 18 USPQ 2d 1016 (fed. Cir. 1991).

UM 3/26/07

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 8-11, 13-19, 22, 25, 26 and 28-33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bugosh (US 2,915,475).

Bugosh teaches the instant fibrous bohemite at col. 15, line 13 to col. 16, line 44 (note that 1 millimicron = 1 nm) and in examples. Specific surface area of 200 to 400

m^2/g is taught at col. 19, lines 15-18. Use of 1-40% of said bohemite in aqueous paints such as polyacrylic esters with or without other emulsifier is taught at col. 29, lines 1-21. Use of a pH 5 or higher for an aqueous dispersion is taught at col. 24, lines 20-31.

Thus, the invention lacks novelty.

Claims 1-34 are rejected under 35 U.S.C. 103(a) as obvious over Bugosh (US 2,915,475).

The instant invention further recites flow and leveling value, sag resistance value, dry time, low shear viscosity recovery value and pH over Bugosh.

It would have been obvious to one skilled in the art at the time of invention to make an (aqueous) paint having the instantly recited properties in Bogush since such properties are well known to paints which one can buy from home improvement stores absent showing otherwise.

Claims 1-9, 12 and 15-21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshino et al (US 6,576,324).

Yoshino et al teach the instant the instant plate- and needle-shaped boehmite particles in table 1 and a dispersion coating with polyvinyl alcohol thereof at col. 30, lines 26-32 (examples 19-22). Said plate-shaped bohemite inherently possesses the instant secondary aspect ratio, and table 2 shows the instant BET value. Said coating

composition inherently meets the instant flow and leveling value, sag resistance value, dry time, low shear viscosity recovery value and pH.

Thus, the invention lacks novelty.

Claims 1-12 and 15-21 are rejected under 35 U.S.C. 103(a) as obvious over Yoshino et al (US 6,576,324).

The instant invention further recites different amount of boehmite over Yoshino et al.

However, it would have been obvious to one skilled in the art at the time of invention to change the concentration of bohemite In order to obtain different coating thicknesses or coating times on different substrates in Yoshino et al since such practice in coating is a *prima facie* obviousness.

Claims 1-3, 8-11, 13-19, 22 and 25-33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Napier (US 3,357,791).

Napier teaches fibrous bohemite having an aspect ratio of at least 15 (300/20 = 15) and a largest dimension of 30-3000 nm (10 angstroms = 1 nm) at col. 3, lines 4-15 and at col. 7, lines .5-26. Said bohemite inherently possesses the instant BET value. Use of said fibrous boehmite as a thickener in an aqueous emulsion containing resins is taught at col. 11, lines 64-71.

Thus, the invention lacks novelty.

Claims 1-34 are rejected uunder 35 U.S.C. 103(a) as obvious over Napier (US 3,357,791) with or without Bugosh (US 2,915,475).

The instant invention further recites acrylic latex paint over Napier. Bugosh teaches use of 1-40% of said bohemite in aqueous paints such as polyacrylic esters with or without other emulsifier is taught at col. 29, lines 1-21.

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known acrylic resin in Napier with or without teaching of Bugosh since and since Napier teaches coaitns using synthetic resins at col. 11, line 68 and since an aqueous latex acrylic paint is well known in the art as taught by Bugosh absent showing otherwise.

The prior art (A2, Anonymous article on internet) filed on December 22, 2005 has been crossed-out since the date (at least a publication year) is missing.

Updated continuation data at the beginning of specification are needed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/March 26, 2007